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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,672	07/02/2004	Maria A. Bednarek	20954P	3103
210	7590	06/29/2006		EXAMINER
MERCK AND CO., INC				KAM, CHIH MIN
P O BOX 2000				
RAHWAY, NJ 07065-0907			ART UNIT	PAPER NUMBER
			1656	

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/500,672	BEDNAREK, MARIA A.
	Examiner	Art Unit
	Chih-Min Kam	1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21, 23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) 1-21, 23 and 25-28 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## DETAILED ACTION

1. In the preliminary amendment filed July 2, 2004, claims 19, 21, 23 and 26-28 have been amended, and claims 22 and 24 have been cancelled, thus claims 1-21, 23 and 25-28 are pending.

### *Election/Restrictions*

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-20, drawn to an optionally substituted peptide having a cyclic structure,  $Z^1-X^1-X^2-X^3-X^4-X^5-X^6$ -cyclo( $X^7-X^8-X^9-X^{10}-X^{11}-X^{12}-X^{13}-X^{14}-X^{15}$ )- $X^{16}-X^{17}-Z^2$  such as amino acid sequence of SEQ ID NO: 29, 30, 31, 32, 33 and 34, and a method of screening for a compound able to bind MCH-1R by measuring the ability of the compound to effect binding the peptide MCH-1R.

Group II, claim 21, drawn to a method for selectively producing MCH1R activity comprising the step of providing a cell functionally expressing MCH-1R with the peptide of  $Z^1-X^1-X^2-X^3-X^4-X^5-X^6$ -cyclo( $X^7-X^8-X^9-X^{10}-X^{11}-X^{12}-X^{13}-X^{14}-X^{15}$ )- $X^{16}-X^{17}-Z^2$ .

Group III, claims 23 and 25, drawn to a method of screening for a MCH-1R antagonist using the peptide of  $Z^1-X^1-X^2-X^3-X^4-X^5-X^6$ -cyclo( $X^7-X^8-X^9-X^{10}-X^{11}-X^{12}-X^{13}-X^{14}-X^{15}$ )- $X^{16}-X^{17}-Z^2$ .

Group IV, claims 26 and 27, drawn to a method for increasing weight or increasing appetite in a subject comprising administering to the subject one peptide having a cyclic structure,  $Z^1-X^1-X^2-X^3-X^4-X^5-X^6$ -cyclo( $X^7-X^8-X^9-X^{10}-X^{11}-X^{12}-X^{13}-X^{14}-X^{15}$ )- $X^{16}-X^{17}-Z^2$ .

Group V, claim 28, drawn to a method for measuring the ability of a compound to decrease weight or appetite in a subject comprising the step of administering to the subject one peptide having a cyclic structure,  $Z^1-X^1-X^2-X^3-X^4-X^5-X^6$ -cyclo( $X^7-X^8-X^9-X^{10}-X^{11}-X^{12}-X^{13}-X^{14}-X^{15}$ )- $X^{16}-X^{17}-Z^2$  to produce a weight increase or appetite increase, administering said compound to said subject, and measuring the change in weight or appetite of said subject.

Should Invention I, II, III, IV or V be elected, applicant is required to select one (1) amino acid sequence having each amino acid residue defined and identified by a "SEQ ID NO.". Each amino acid sequence, which has different amino acid sequence, different physical and chemical properties, and produce different effect, is patentably distinct. See, e.g., Tables 1-6 in the specification which demonstrate differences in effect and action for different sequences. This is not species election.

The claims of these groups are directed to different inventions, which are not linked to form a single general concept. The claims in the different groups do not have in common the same or corresponding technical features. In particular, each group is directed to distinct peptides and/or methods, which use different materials and produce different effects. Accordingly, the claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept and lack of unity is deemed proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.  
Primary Patent Examiner



CHIH-MIN KAM  
PATENT EXAMINER

CMK  
June 23, 2006